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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,609	07/02/2003	Ronald A. Underwood	E-11	7304
21394	7590	07/26/2005		
ARTHROCARE CORPORATION 680 VAQUEROS AVENUE SUNNYVALE, CA 94085-3523			EXAMINER PEFFLEY, MICHAEL F	
			ART UNIT 3739	PAPER NUMBER
DATE MAILED: 07/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

John

Office Action Summary	Application No. 10/613,609	Applicant(s) UNDERWOOD ET AL.	
	Examiner Michael Peffley	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 24-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18, 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 19 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/16/03</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>10/21/03</u> | |

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Election/Restrictions

Applicant's election of the invention of Group I, claims 1-23 in the reply filed on May 16, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 24-34 are withdrawn from further consideration.

Information Disclosure Statement

The information disclosure statement filed October 6, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

In particular, select references have not been considered as indicated on the attached initialed copy of the form USPTO-1449. Copies of several of the references were not found in the submitted papers, or the copies were so illegible that they could not be identified and matched with the entry on the form. It is noted that the examiner also noted certain documents which were submitted with the IDS that did not seem to appear on the PTO-1449.

Specification

The disclosure is objected to because of the following informalities: the Cross-Reference to Related Applications section must be amended to provide the most current status (i.e. US Patent Numbers) of the related applications.

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Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Hissong et al (6,413,254).

Hissong et al provides an ultrasonic ablation device that is used to reduce/remove tissue internal to the tongue without penetrating the mucosal surface of the tongue (see Figures 8-13 and Abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (5,879,349) in view of the teaching of Edwards (5,823,197) and Edwards (5,800,429).

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Edwards ('349) disclose an ablation device for reducing or debulking a tongue. The method of using the device includes piercing the tongue with RF electrodes and ablate the tissue in the interior of the tongue. The device and method fails to debulk the tongue without penetrating the surface mucosal layer of the tongue.

Edwards ('197) and Edwards ('429) both disclose an analogous RF treatment device for ablating interior tissue. In each, Edwards teaches that the interior of nasal tissue may be ablated. In particular, Edwards('197) teach that the tissue may be ablated by penetrating the tissue with RF needle electrodes (i.e. as in the Edwards '349 method), and Edwards ('429) disclose the same procedure using non-penetrating energy delivery.

To have provided the Edwards ('349) device with a non-penetrating energy delivery means to ablate an interior surface of the tongue would have been an obvious alternative for one of ordinary skill in the art, particularly since Edwards ('197) and Edwards ('429) show the obvious use of either penetrating needles or non-penetrating energy means for treating a tissue interior.

Allowable Subject Matter

Claims 1-18, 22 and 23 are allowed.

Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The prior art fails to disclose the particular method step of accessing the interior of the tongue via an incision as set forth in the claims indicated as allowable.

Conclusion

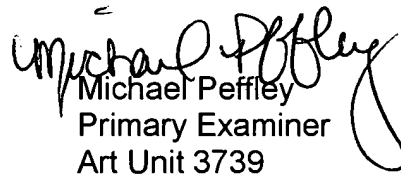
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sohn et al (5,988,171) and Goble (2005/0090819) disclose RF devices for reducing tongue tissue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

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July 22, 2005